

Hearing:  
August 27, 1997

Paper No. 26  
SIMMS/MD

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

JUNE 17, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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DBNA Trademarks Holding Inc.

v.

Tilco, Inc.

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Opposition No. 99,103  
to application Serial No. 74/526,133  
filed on May 18, 1994

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Joseph B. Bowman of Kokjer, Kircher, Bowman & Johnson for  
DBNA Trademarks Holding Inc.

Jerald E. Nagae of Christensen, O'Connor, Johnson, Kindness  
for Tilco, Inc.

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Before Simms, Seeherman and Walters, Administrative  
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

DBNA Trademarks Holding Inc. (opposer) has opposed the  
application of Tilco, Inc. (applicant), a Washington  
corporation, to register the mark VANGUARD for  
"reconstruction services, namely, modification of pavement,

streets and road surfaces to apply warning bumps.”<sup>1</sup> In the notice of opposition, opposer asserts that, through its licensees, it makes and sells a variety of machines, tools and accessories for material-removal operations including such goods as “power operated asphalt, concrete, brick, ceramic, glass, masonry, metal, refractory, stone, terrazzo, tile, wall and cut-off saws, grinders, groovers, planers, scarifiers, sanders, polishers, washers, particulate collectors, drills, saw blades, wire brushes, profile wheels, grinding wheels, lapidary blades, core bits and cup wheels.” (Notice of Opposition, Par. 2) Opposer also pleads ownership of a registration (Registration No. 674,041, issued February 17, 1959, Sections 8 and 15 affidavit filed, renewed) for the mark VANGUARD for abrasive tools, particularly grinding wheels. Opposer asserts that through its licensees and predecessors it has used this mark for abrasive tools prior to any date that applicant may assert, and that applicant’s mark so resembles opposer’s previously used and registered mark as to be likely to cause confusion, to cause mistake or to deceive. In its answer, applicant has denied the essential allegations of the notice of opposition.

Both parties have taken testimony, and the record of

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<sup>1</sup> Application Serial No. 74/526,133, filed May 18, 1994, based upon applicant’s bona fide intention to use the mark in commerce under Section 1(b) of the Act, 15 USC §1051(b).

this case contains two testimony depositions (and exhibits) submitted by opposer and one testimony deposition (and exhibits) submitted by applicant. The application file also forms part of this record. Briefs have been filed and an oral hearing was held.

The Record

Mr. Lyle Stone, the president of the North American sales division of opposer's licensee, Diamant Boart, Inc., testified that Diamant Boart makes and sells abrasive cutting tools (diamond saw blades and grinding wheels) under the mark VANGUARD. These tools are used in opposer's walk-behind and ride-on equipment for cutting and grooving and/or grinding concrete, asphalt as well as stone. The cutting tools themselves range in price from \$366 to around \$1225, while the concrete saws in which the cutting tools are used may cost around \$7,500. The grooving machines (or groovers) and concrete saws (bearing other trademarks) may be used, among other things, to cut grooves or channels into highway (and sidewalk) surfaces into which highway marking systems including bumps (made by others) may be installed. Stone dep., 57, 60. Markers such as reflectors, speed bumps and rumble strips may also be installed into the grooves or channels formed by the use of opposer's equipment. Grinders and groovers are also designed to level or smooth a surface and to leave behind a textured surface that greatly enhances

the skid resistance of that surface. The equipment may also be used to leave a depression that acts as a rumble strip or a warning indicator to alert the public of a change in a traffic pattern. Opposer's goods, including its saw blades and grinding wheels, are sold to distributors (full line, specialty and industrial), rental houses or shops, large professional cutters, highway contractors, building contractors and welding supply houses, as well as to end users needing equipment for material-removal operations. The goods are promoted by way of catalogs, fliers, in trade journals and at trade shows. Sales under the mark exceeded \$1.7 million in 1995. There have been no instances of actual confusion involving opposer's and applicant's marks.

Opposer also took the testimony of Mr. Richard Norland, manager of technical services of Diamant Boart. According Mr. Norland, there are two methods of applying warning bumps or tactile surfaces to alert motorists and pedestrians. One of them is to grind or saw or groove a depression into the road surface while the other is to apply a raised structure as a tactile indicator. Norland dep., 8. With respect to applicant's services, Mr. Norland testified, at 10:

- A. It's quite similar to a method that currently is described in the industry as a Tactile Tile which are large 2-foot by any dimen--they can either be square or rectangular or linear--long linear dimension; tiles that have a raised bump on them and that are affixed to a surface. [A]nd

they are very similar also to painted-on or glued-on speed bumps, only they would be a long, thin rectangular structure whereas this is a series of dots or domes.

Applicant took the testimony of Mr. Jon Julnes, one of its employees. With respect to its VANGUARD reconstruction services and the "detectable warnings" that applicant applies to surfaces, Mr. Julnes testified, at 5:

- A. They are like Braille for your feet. They allow a blind person to know when they are about to enter either a grade change or the transition point from vehicular way and pedestrian way, and they help a visually impaired person or sight impaired, any kind of lack or percentage loss to be able to discern most of the same things by vision rather than by Braille or tactile.

Applicant applies to the top of a surface various bumps or protrusions, some of which may result by pouring a liquid over a mat or template.

According to Mr. Julnes, architects are normally the "focal point" who contact applicant (Julnes dep., 15). Building inspectors may also be involved. Applicant's reconstruction services are offered under a general building contractor and the services are paid for by a store or building owner. While applicant's services vary in cost from \$12 to \$17 per square foot, the total cost of any one job is usually thousands of dollars. Applicant's services have been listed under the heading "Detectable Warnings" in

construction directories. Applicant advertises its services in construction newspapers and in trade magazines.

Mr. Julnes testified that applicant does not sell saws or abrasive tools. Also, there have been no instances of actual confusion or even inquiries concerning the relatedness of the parties' goods and services offered under the mark VANGUARD.

The Parties' Arguments

Opposer argues that its licensee Diamant Boart and its predecessors have long used the mark VANGUARD for abrasive tools, including diamond saw blades, for cutting pavement, streets and road surfaces. Essentially, it is opposer's position that opposer's products, on the one hand, may be used to cut warning bumps into a roadway surface while applicant's services, on the other, may result in the application of a similar tactile warning system on a roadway. Opposer maintains that these two systems are in direct competition. Opposer contends that its tools can grind sections of roadway so that tactile tile may be installed, or its equipment can cut or grind a roadway surface so as to form a warning bump.

...The parties are direct competitors in providing a tactile warning surface to pavements, streets and road surfaces. Both parties advertise and promote their products to construction contractors. Under such circumstances, the possibility is great that a customer in need of a tactile warning surface could

use a Diamant Boart VANGUARD saw blade to cut a pavement, street or road surface in order to make the tactile warning as an alternative to the VANGUARD warning system offered by Tilco [applicant], or that both products were used in conjunction with one another in order to install the warning surface.

Opposer's brief, 12. Opposer argues that professional cutters could use opposer's cutting tools to install applicant's VANGUARD marking system. Finally, opposer argues that any doubt in this case should be resolved in its favor and against the newcomer.<sup>2</sup>

Applicant, on the other hand, maintains that, while the marks of the parties are the same, its mark is used in conjunction with the application of an epoxy-like liquid or a resin to an asphalt or concrete surface in an operation that involves no grinding, sawing or degrading of the surface. Applicant contrasts its application of warning bumps to opposer's goods which cut, gouge or grind away a surface using grinders, groovers, sanders, saw blades, grinding wheels, etc. Opposer's goods leave behind a

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<sup>2</sup> Opposer has also objected to certain of applicant's exhibits on the basis of lack of foundation, lack of authentication and irrelevancy. In response, applicant argues that opposer's objections in its brief should be deemed to have been waived because opposer did not appear at the deposition and, consequently, raised no objections at that time. According to applicant, opposer's objections could have been cured if they were promptly presented. Applicant relies upon Fed. R. Civ. P. 32(d) and Squirtco. v. Tomy Corp., 697 F.2d 1034, 216 USPQ 937, 939 n.4 (Fed. Cir. 1983). Opposer's objections are not well taken, and we have allowed applicant's exhibits for whatever probative value they may have.

textured skid-resistant surface which, according to applicant, does not resemble a warning bump, the result of applicant's services. Applicant states that none of opposer's abrasive tools are used in the provision of applicant's services. Applicant argues that there is no evidence in this record that a consumer in need of a tactile warning surface such as those described in applicant's application could use opposer's VANGUARD saw blade as an alternative. Moreover, applicant maintains that opposer has not used the VANGUARD mark in connection with the abrasive tools (grinding wheels) set forth in its pleaded registration since 1989 but has only used the mark in connection with diamond-tipped saw blades since that time.<sup>3</sup> Applicant maintains that the channels of trade are also different with opposer's goods being sold to distributors, rental shops, professional cutters and road construction contractors while applicant's services are promoted to building contractors and architects. Applicant also points to the cost of the respective goods and services, opposer's saw blades costing over \$300 to around \$1,300. Therefore, according to applicant, the purchasers

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<sup>3</sup> Applicant claims, therefore, that opposer's registration is "subject to cancellation." Brief, 9. However, applicant did not file a counterclaim to cancel opposer's pleaded registration and, therefore, we have considered that registration as valid and subsisting. In any event, opposer has established prior common law rights in the mark VANGUARD in connection with various abrasive tools including saw blades.



are careful and sophisticated. Applicant also argues that opposer's mark is not famous and that there have been no instances of actual confusion with neither party in fact ever having heard of the other before the filing of applicant's application.

Discussion and Opinion

The sole issue for our resolution is likelihood of confusion. Priority is not an issue in view of opposer's valid and subsisting registration. See *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). However, even without the pleaded registration, opposer's priority is clear from the testimony and exhibits of record.

Because the marks herein are identical, the resolution of this case turns on the relationship of the goods and services of the parties. After careful consideration of this record and the arguments of the parties, we conclude that confusion is unlikely. While one might envision a scenario where the same purchaser is exposed to the marks of both parties, we believe that such a scenario is quite unlikely. Moreover, even if it should occur, the likelihood of confusion under the circumstances would be rather remote. It may be possible, for example, for a building or a highway contractor to purchase some of opposer's equipment, including its VANGUARD saw blades, to

perform a job during the construction of a building or a highway, and also to employ applicant to perform its reconstruction services (say, to apply warning bumps to a sidewalk) under the service mark VANGUARD. However, even if this were to occur, it is unlikely that the contractor would be confused as to the source of the goods and services under the marks. This is because, among other reasons, opposer's mark VANGUARD is used only on the saw blades (or the grinding wheels) of opposer's grinding or grooving machines or concrete saws. It is not used on the machines or saws themselves. Also, this mark is only one of opposer's marks employed on its equipment and components.<sup>4</sup> Moreover, a contractor, who must be assumed to be a relatively sophisticated purchaser, is unlikely to associate applicant and its reconstruction services with opposer due to the similarity of the marks because applicant's services of applying warning bumps do not involve the use of cutting machines or saws but merely the application of warning bumps by means of placing a liquid over a mat or a template. The application of warning bumps to a surface has little or nothing in common with saw blades and grinding wheels except for the fact that the

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<sup>4</sup> For example, opposer also uses the marks BANNER LINE, MILLENIUM and SUPERLOK on its saw blades. We need not decide the hypothetical question of whether confusion would be likely if opposer were to use the mark VANGUARD on its grooving and

latter *may* be used, at least in one application, to create grooves or channels for the placement of warning devices. Accordingly, even if there were common purchasers of opposer's goods and applicant's services, it is our conclusion that it is unlikely that any confusion as to source would occur.

Decision: The opposition is dismissed.

R. L. Simms

E. J. Seeherman

C. E. Walters  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

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grinding machines, although this would undoubtedly present a closer case.